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MOTOROLA, INC.
CORPORATE LAW DEPARTMENT - #56-238
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OFFICE OF PETITIONS

In re Application of
Rosenstock, Dykiel, Lagueux, and
Duthie
Application No. 10/676,644
Filed: 30 September, 2003
Atty Docket No. IS01409MCG

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DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed under 37 CFR 1.47(a) on 20 January, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 30 September, 2003, without an executed oath or declaration. Accordingly, on 22 December, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing.

In response, on 20 January, 2004, petitioners filed a declaration naming Harold N. Rosenstock, Richard Dykiel, Richard Lagueux, and Peter Duthie as joint inventors, signed by joint inventor Rosenstock on behalf of himself and the other inventors, the present petition, petition fee, and the late-filing surcharge.

Petitioners state that joint inventors Dykiel, Lagueux, and Duthie cannot be reached or have refused to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1).

In regards to item (1), petitioners have not provided proof that joint inventors Dykiel and Lagueux were ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ The petition states that Kevin D. Wills made a bona fide and diligent attempt to present the application papers to joint inventors Dykiel and Lagueux. However, the petition does not show that a copy of the application papers (specification, claims, drawings, if any, and the declaration) were ever sent or given to joint inventors Dykiel and Lagueux.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact. While petitioners have presented emails from joint inventors Dykiel and Lagueux indicating an unwillingness to join in the filing of the application papers, both joint inventors must be afforded an

¹ MPEP 409.03(d).

opportunity to review the application papers. Petitioners should sent or give the non-signing inventors a copy of the application papers as specified above at their respective last known addresses with a request that they sign and return the declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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